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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

IYER et al.

Serial No. 09/581,122

Filed: June 15, 1998

Art Unit: unassigned

Examiner: unassigned

Attorney Docket No.: 98-503-US

FETAL OXIMETRY SYSTEM  
AND SENSOR

Pittsburgh, Pennsylvania 15230

**SECOND RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)  
TO EXECUTE APPLICATION FOR NON-SIGNING INVENTORS**

BOX PCT  
Commissioner for Patents  
Washington, DC 20231

Sir:

Applicants Vijah K. Iyer, Christopher A. Cutler, William D. Wallace, Steven R. Smith, Daniel J. McGraw, Clifford G. Montagnoli and Trent W. Banks, joint inventors of the above-identified invention, hereby respectfully request authorization to execute the subject patent application under 37. C.F.R. § 1.47(a) on behalf of joint inventor Robert M. Johnson, who after diligent effort has not been found to join in this application and on behalf of join inventors Johannes Buschmann, Reinhold Falkowski and Nick Tu who refuse to join in this application.

## I. Proof of Pertinent Facts

As evidenced by the Declaration of Cheryl L. Gastineau ("Ms. Gastineau"), agent for Applicants, a copy of which is attached hereto as Attachment 1, Robert M. Johnson has not been found to join in the U.S. application and execute the Declaration after reasonable and diligent efforts were taken. Also, Johannes Buschmann, Reinhold Falkowski and Nick Tu have refused to join in the U.S. application and execute the Declaration after reasonable and diligent efforts were taken.

## II. The Action Is Necessary To Preserve The Rights Of The Parties Or Prevent Irreparable Harm

To execute the subject application the combined Declaration and Power of Attorney document must be signed and filed. As demonstrated above, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu have not been found or refuse to sign the declaration document. Thus, to prevent the subject application from being abandoned and to otherwise to protect the other joint inventors and Assignee Respirationics, Inc.'s patent rights, it is necessary for the other joint inventors to execute the subject application on behalf of Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu under 37. C.F.R. § 1.47(a).

## III. Last Known Address of Non-Signing Inventors

Robert M. Johnson  
481 Ivy Park Lane  
Atlanta, GA 30342

Johannes Buschmann  
Birkenleiten 9  
D81453 Munich  
Federal Republic of Germany

Reinhold Falkowski  
Birkenleiten 9  
D81453 Munich  
Federal Republic of Germany

Nick Tu  
6333 Lauderdale St.  
West Palm Beach, FL 33410

#### IV. Conclusion

For the reasons presented above, Applicants respectfully submit that Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu, who are believed to be inventors in the above-identified U.S. application have not been found or refuse to execute the application, as set forth in the Declaration of Ms. Gastineau at Attachment 1.

Accordingly, Applicants respectfully request the authorization under 37. C.F.R. § 1.47(a) to file the above-identified U.S. application on behalf of the non-signing joint inventors, Robert M. Johnson, Johannes Buschmann, Reinhold

Falkowski and Nick Tu, be granted and that a Notice to that effect be provided.

Respectfully submitted,



Dated: June 3, 2002

---

Cheryl L. Gastineau  
Reg. No. 39,469

REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
(412) 288-4152

Agent for Applicants

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PCT Patent Application of:

IYER et al.

Serial No.: 09/581,122

Filed: June 15, 1998

Art Unit: unassigned

Examiner: unassigned

Atty. Docket No.: 98-503-US

FETAL OXIMETRY SYSTEM  
AND SENSOR

BOX PCT  
Commissioner for Patents  
Washington, D.C. 20231

DECLARATION OF MS. CHERYL L. GASTINEAU

Sir:

I am a patent agent with Registration No. 39,469 with  
Reed Smith LLP, P.O. Box 488, Pittsburgh, Pennsylvania 15230.

Robert M. Johnson

On March 29, 2001, I sent Robert M. Johnson  
("Mr. Johnson") a letter (Exhibit A) via first class mail to  
Robert M. Johnson, 481 Ivy Park Lane, Atlanta, GA 30342. The  
letter requested he sign and date an enclosed Combined  
Declaration and Power of Attorney ("Declaration") for the above-  
identified patent application and to return said Declaration to  
me no later than one week from receipt in an enclosed "prepaid

postage" envelope. The envelope in which the letter was enclosed was returned by the United States Postal Service as "RETURNED TO SENDER UNDELIVERABLE AS ADDRESSED UNABLE TO FORWARD."

(Exhibit B)

On September 24, 2001, I sent Mr. Johnson a package via U.S. Express Mail. Included in the package was a cover letter (Exhibit C), a Declaration and a copy of the above-identified patent application. The package was returned as "RETURNED TO SENDER UNDELIVERABLE AS ADDRESSED UNABLE TO FORWARD." (Exhibit D)

On April 30, 2001, I contacted Leila Mobley of Respironics, Inc. to inquire if she could provide different addresses for the non-signing inventors. She contacted me on May 11, 2001 (Exhibit E) to indicate she could not find an address for Robert M. Johnson. On May 20, 2002, I asked my law firm's library for help in helping me find a current address for Mr. Johnson. On May 30, 2002, Ms. Lori Hagen from our library e-mailed me the results (Exhibit F) of a search finding Robert M. Johnson formerly of 481 Ivy Park Lane, Atlanta, Georgia, now having an address of 2 Southerland Rd., Savannah, GA 31411-2536 and a telephone number of (912) 598-3760.

On June 3, 2002, I called (912) 598-3760 and received a recording that the number has been disconnected or is no longer in service. Also, on June 3, 2002, I sent a letter (Exhibit G) to Mr. Johnson at the Savannah address including a copy of the

application entitled "Fetal Oximetry System and Sensor" and a copy of the declaration for his signature.

Johannes Buschmann

On March 29, 2001, I sent Johannes Buschmann ("Mr. Buschmann") a letter via first class mail (Exhibit H) to Johannes Buschmann, Birkenleiten 9, D-81453 Munich, Federal Republic of Germany. The letter requested he sign and date an enclosed Combined Declaration and Power of Attorney ("Declaration") for the above-identified patent application and to return said Declaration to me no later than one week from receipt in an enclosed "prepaid postage" envelope.

I mailed a second request on May 31, 2001 to Mr. Buschmann at Birkenleiten 9, D-81453 Munich, Federal Republic of Germany and also faxed to him a request at No. 011-49-89-680-6650 (Exhibit I).

On September 24, 2001, I sent Mr. Buschmann a package via DHL. Included in the package was a cover letter (Exhibit J), a Declaration and copy of the above-identified patent application.

On May 31, 2002 and June 3, 2002, I contacted Mr. Buschmann via telephone at 011-49-89-680-6050. During this telephone conversation I asked Mr. Buschmann if he had received a copy of the application entitled "Fetal Oximetry System and Sensor" and accompanying declaration. He indicated he had. I offered to send another copy of the application and declaration



to him and Mr. Falkowski but he indicated that that would not be necessary because they already had copies. Mr. Buschmann said that he would not sign the declaration on the advice of his attorney.

Reinhold Falkowski

On March 29, 2001, I sent Reinhold Falkowski ("Mr. Falkowski") a letter (Exhibit K) via first class mail to Reinhold Falkowski, Birkenleiten 9, D-81453 Munich, Federal Republic of Germany. The letter requested he sign and date an enclosed Combined Declaration and Power of Attorney ("Declaration") for the above-identified patent application and to return said Declaration to me no later than one week from receipt in an enclosed "prepaid postage" envelope. I mailed a second request on May 31, 2001 to Mr. Falkowski at Birkenleiten 9, D-81453 Munich, Federal Republic of Germany and also faxed to him a request at No. 011-49-89-680-6650 (Exhibit L).

On September 24, 2001, I sent Mr. Falkowski a package via DHL. Included in the package was a cover letter (Exhibit M), a Declaration and copy of the above-identified patent application.

On June 3, 2002, I contacted Mr. Falkowski via telephone at 011-49-89-66-1147. During this telephone conversation, Mr. Falkowski indicated that he would not sign the declaration on the advice of his attorney.

Nick Tu

I sent Mr. Nick Tu ("Mr. Tu") at the address of 444 South Ivy Drive, Midvale, UT 84047 a letter dated January 18, 2001 (Exhibit N). Enclosed with the letter in an envelope was a copy of U.S. Patent Application No. 09/581,122 and a Combined Declaration and Power of Attorney ("Declaration") to be executed by Mr. Tu for said application. Also enclosed was an Assignment of Mr. Tu's inventorship rights to the invention in the above-referenced application to the Applicant, Respironics, Inc. The letter requested Mr. Tu to sign and date both the Declaration and the Assignment and return them no later than one week after receipt.

The envelope (Exhibit O) was returned to us unopened on January 29, 2001 and stamped with the message "RETURN TO SENDER, NO SUCH NUMBER."

My secretary searched the internet and found a Nicholas Tu at 8188 Ivy Drive, Midvale, UT 84047. We remailed the contents of the previously identified envelope on January 30, 2001 (Exhibit P).

We sent an additional request to Nicholas Tu at 8188 Ivy Drive, Midvale, UT 84047 on May 31, 2001 (Exhibit Q).

On September 24, 2001, I sent Mr. Tu a package via U.S. Express Mail (Exhibit R). Included in the package was a cover letter (Exhibit O), a Declaration and copy of the above-

identified patent application. The package was returned as "RETURN TO SENDER UNCLAIMED" (Exhibit S).

On May 30, 2002, I performed an internet search through www.bigfoot.com and obtained three listings for "Nick Tu" in the United States (Exhibit T). On June 3, 2002, I called Nick Tu of 6333 Lauderdale St., West Palm Beach, FL 33410 at 561-799-2014 and ascertained that he is the Nick Tu of the subject application. He indicated to me that he had received a copy of the application entitled "Fetal Oximetry System and Sensor" and declaration but that he refused to sign them. I told Mr. Tu that I would send him an additional copy to his new address (see letter in Exhibit U) and he indicated that he would refuse to sign anything.

Mr. Tu also refused to take part of the PCT application PCT/US98/12394 corresponding to this application as evidenced by the Renewed Petition under 37 C.F.R. § 1.425 (Exhibit Q), Second Request for Filing by Other than Inventor under PCT Rule 4.15(b) and 37 C.F.R. § 1.425(b) (Exhibit W), Declaration of Michael Haas (Exhibit X), Declaration of Cheryl L. Gastineau (Exhibit Y) and the Decision on Renewed Petition (Exhibit Z).

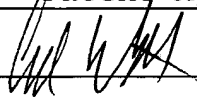
I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or

imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: November 13, 2001

Name: Cheryl L. Gastineau

Title: Patent Agent

Signature: 

# **EXHIBIT A**

March 26, 2001

VIA U.S. FIRST CLASS MAIL

Mr. Robert M. Johnson  
481 Ivy Park Lane  
Atlanta, GA 30342

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Johnson:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli and Banks.

Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers.

Kindly return the signed Declaration to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed documents in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By 

Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Express Mail Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

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# **EXHIBIT B**

**Gastineau, Cheryl L.**

---

**From:** Mobley, Leila H. [Leila.Mobley@respironics.com]  
**Sent:** Friday, May 11, 2001 9:58 AM  
**To:** Gastineau, Cheryl L.  
**Subject:** RE: addresses

Cheryl,  
Attached is the information I was able to get for you. Sorry for the delay,  
I was waiting on one answer from our Georgia office. The information is in  
all capital letters within your original e-mail.  
Leila

-----Original Message-----

**From:** Gastineau, Cheryl L. [mailto:CGastineau@ReedSmith.com]  
**Sent:** Monday, April 30, 2001 9:37 AM  
**To:** 'leila.mobley@respironics.com'  
**Cc:** ZZ-Haas, Michael  
**Subject:** addresses

Leila,  
Correspondence to Johnson and Smith at the following addresses was  
returned by the Post Office.  
I have not heard anything from the others.  
(The first letter I sent to Mr. Tu at 444 South Ivy Drive was returned by  
the Post Office)  
Your help in getting different addresses and/or phone numbers is greatly  
appreciated.  
Cheryl

Full name of second inventor JOHNSON, Robert M.  
Residence Atlanta, Georgia  
Citizenship United States of America  
Post Office Address 481 Ivy Park Lane  
Atlanta, GA 30342  
(COULD NOT FIND AN ADDRESS FOR HIM)

Full name of third inventor BUSCHMANN, Johannes  
Residence Munich, Federal Republic of Germany  
Citizenship Federal Republic of Germany  
Post Office Address Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany  
(PHONE NUMBERS FOR BOTH BUSCHMANN AND FALKOWSKI -- 011-49-89-680-6050  
(phone)

011-49-89-680-6650 (fax)

Full name of fourth inventor FALKOWSKI, Reinhold  
Residence Munich, Germany  
Citizenship Federal Republic of Germany  
Post Office Address Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany

Full name of seventh inventor SMITH, Steven R.  
Residence Draper, Utah



# **EXHIBIT C**

September 24, 2001

VIA EXPRESS MAIL

Mr. Robert M. Johnson  
481 Ivy Park Lane  
Atlanta, GA 30342

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Johnson:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Cutler, Wallace, McGraw, Smith, Tu, Montagnoli and Banks.

Please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

  
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

U.S. Serial No. 09/581,122

Express Mail Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

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# **EXHIBIT D**



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## POST OFFICE TO ADDRESSEE

EK409164237US

## ORIGIN (POSTAL USE ONLY)

Post ZIP Code 15232	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In 02-10	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$ 16.25
Time In 8:00	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee \$ 1.50
Weight 14.4 lbs.	Int'l Alpha Country Code	COD Fee
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials	Insurance Fee
Total Postage & Fees \$ 17.75		

## DELIVERY (POSTAL USE ONLY)

Delivery Attempt	Time 11 AM	Employee Signature
Mo. Day	<input type="checkbox"/> A <input type="checkbox"/> PM	
Delivery Attempt	Time	Employee Signature
Mo. Day	<input type="checkbox"/> A <input type="checkbox"/> PM	
Delivery Date	Time	Employee Signature
Mo. Day	<input type="checkbox"/> A <input type="checkbox"/> PM	
Signature of Addressee or Agent		
X	Name - Please Print	
X		

## CUSTOMER USE ONLY

## METHOD OF PAYMENT:

Express Mail Corporate Acct. No.

Federal Agency Acct. No. or  
Postal Service Acct. No.

☐ **WAIVER OF SIGNATURE** (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.

☐ **NO DELIVERY** ☐ Weekend ☐ Holiday

Customer Signature

FROM: (PLEASE PRINT)

PHONE (412) 288-4152

Cheryl L. Gastineau  
Reed Smith LLP  
435 6th Avenue  
Pittsburgh, PA 15219

157848.20177.1460

TO: (PLEASE PRINT)

PHONE ( )

Mr. Robert M. Johnson  
481 Ivy Park Lane

RETURNED  
TO SENDER

UNDELIVERABLE AS  
ADDRESSED  
UNABLE TO FORWARD

PRESS HARD.

You are making 3 copies.

FOR PICKUP OR TRACKING CALL 1-800-222-1811

WWW.USPS

Label 11-B September 1999

Facing Label  
Address

# **EXHIBIT E**

Citizenship United States of America  
Post Office Address 1116 East 13200 S  
Draper, UT 84020  
(ADDRESS IS CORRECT, HAVE NO PHONE LISTING FOR HIM)

Full name of ninth inventor TU, Nick  
Residence Midvale, Utah  
Citizenship United States of America  
Post Office Address 8188 Ivy Drive  
Midvale, UT 84047  
(THIS IS ADDRESS I HAVE FOR HIM IS THE ADDRESS YOU MENTIONED ABOVE)

Full name of tenth inventor MONTAGNOLI, Clifford G.  
Residence Murray, Utah  
Citizenship United States of America  
Post Office Address 5758 South Butler Circle  
Murray, UT 84107  
(HAVE NO PHONE LISTING FOR HIM)

# **EXHIBIT F**

**Gastineau, Cheryl L.**

---

**From:** Hagen, Lori J.  
**Sent:** Thursday, May 30, 2002 5:32 PM  
**To:** Gastineau, Cheryl L.  
**Subject:** FW: LexisNexis(TM) Email Request (967:0:55532025)  
(967:0:55532025)

-----Original Message-----

From: LexisNexis Print Delivery [<mailto:lexisnexis@prod.lexisnexis.com>]  
Sent: Thursday, May 30, 2002 5:29 PM  
To: Hagen, Lori J.  
Subject: LexisNexis(TM) Email Request (967:0:55532025)

1113HR

Print Request: All Documents

Time of Request: May 30, 2002 05:28 PM EDT

Number of Lines: 68

Job Number: 967:0:55532025

Client ID/Project Name:

Research Information:

EZFIND Combined Person Locator Nationwide  
robert /1 m /1 johnson and ga or georgia

Focus:

robert /1 m /1 johnson and ga or georgia and southerland

Note:

johnson results

PAGE 1

FOCUS - 1 of 4 DOCUMENTS

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-SEEK

Name: JOHNSON, ROBERT M (MALE)

Spouse Name: CAROLYN

06/03/2002



Consumer Name Last Updated: 10/1/2000

Address:

2 SOUTHERLAND RD  
SAVANNAH, GA 31411-2536  
Address Type: SINGLE FAMILY  
Address Created: 4/13/2000  
Address Updated: 10/1/2000

Previous Addresses:

481 IVY PARK LN NE  
ATLANTA, GA 30342-4554  
Address Type: SINGLE FAMILY  
Address Created: 2/11/1998  
Address Updated: 2/20/2000

745 MOORING RD APT 209  
OCEAN CITY, MD 21842-4935  
Address Type: HIGH-RISE/APARTMENT  
Address Created: 9/8/1999  
Address Updated: 9/8/1999

Birthdate: 1947

On File Since: 12/30/1989

Date Vendor Record Last Updated: 10/1/2000

FOCUS - 2 of 4 DOCUMENTS

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-SRCH

Name: JOHNSON, ROBERT M

PAGE 2

JOHNSON, ROBERT M

Address:

2 SOUTHERLAND RD  
SAVANNAH, GA 31411  
Address Created: 7/2000

Previous Addresses:

4160 CORALEE LN  
LAFAYETTE, CA 94549  
Address Created: 11/1999

481 IVY PARK LN NE  
ATLANTA, GA 30342  
Address Created: 3/1998

Birthdate: 9/1947

06/03/2002

FOCUS - 3 of 4 DOCUMENTS

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-FIND

Name: JOHNSON, ROBERT M

Consumer Name Last Updated: 6/30/2001

Address:  
2 SOUTHERLAND RD  
SAVANNAH, GA 31411-2536

Telephone: (912) 598-3760

Date Vendor Record Last Updated: 5/7/2002

FOCUS - 4 of 4 DOCUMENTS

THIS DATA IS FOR INFORMATIONAL PURPOSES ONLY

PERSON LOCATOR - P-TRAK

Name: JOHNSON, ROBERT M

Address:  
2 SOUTHERLAND ROAD  
SAVANNAH, GA 31411

PAGE 3

JOHNSON, ROBERT M

Address Updated: 3/1/2000

Previous Addresses:  
481 IVY PARK LANE  
ATLANTA, GA 30342  
Address Updated: 2/1/1998

2870 PHARR COURT APT. 709  
ATLANTA, GA 30305  
Address Updated: 11/13/2000

4397 JETT PLACE  
ATLANTA, GA 30327  
Address Updated: 7/18/2001

Telephone: 705-9448

On File Since: 10/1/1979

1113HR

\*\*\*\*\* Print Completed \*\*\*\*\*

06/03/2002

Time of Request: May 30, 2002 05:28 PM EDT

Print Number: 967:0:55532025

Number of Lines: 68

Number of Pages: 3

# EXHIBIT G

June 3, 2002

VIA EXPRESS MAIL

Mr. Nick Tu  
6333 Lauderdale St.  
West Palm Beach, FL 33410

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

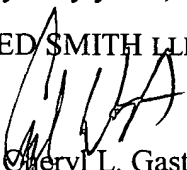
As per our telephone discussion today, please find enclosed a copy of a Combined Declaration and Power of Attorney and a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

As we discussed on the telephone, I understand that you do not wish to sign the declaration or execute the above-referenced application. Should you change your mind, please sign the declaration and return to me. Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Thank you for your time.

Very truly yours,

REED SMITH LLP

By  Cheryl L. Gastineau

CLG:dl

Encs.: Declaration  
U.S. Serial No. 09/581,122  
Express Mail Label and Envelope

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063  
Delaware  
New Jersey  
New York  
Pennsylvania  
United Kingdom  
Virginia  
Washington, DC

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PGHUB-0960001.01-CLGASTIN  
June 3, 2002 4:06 PM

**COMBINED DECLARATION AND POWER OF ATTORNEY**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **FETAL OXIMETRY SYSTEM AND SENSOR**, the specification of which

**Regular Application**

☐ is attached hereto.

☐ was filed on [Date Application was Filed] as Application Serial No. [Serial No.] and was amended on [Date of Amendment] (if applicable).

**PCT Application Entering National Phase**

☒ was filed on June 15, 1998 as PCT International Application No. PCT/US98/12394 and U.S. Application Serial No. 09/581,122 and was amended on [Date of Amendment] (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

**Prior Foreign Application(s)**

**Priority Claimed**

(Number)	(Country)	(Day/Month/Year Filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No
----------	-----------	------------------------	------------------------------	-----------------------------

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

60/050,958	June 17, 1997
(Application Number)	(Filing Date)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

(Application Serial No.)	(Filing Date)	(Status-patented, pending, abandoned)
--------------------------	---------------	---------------------------------------

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Louis M. Heidelberger, Reg. No. 27,899; John W. Goldschmidt, Jr., Reg. No. 34,828; William J. McNichol, Jr., Reg. No. 31,179; R. Anthony Diehl, Reg. No. 38,432; Maryellen Feehery, Reg. No. 44,677; Alison B. Weisberg, Reg. No. 45,206; Carl H. Pierce, Reg. No. 45,730; Nanda P.B.A. Kumar, Reg. No. 44,853; Thomas J. McWilliams, Reg. No. 44,930; Matthew J. Esserman, Reg. No. 41,536; Frederick H. Colen, Reg. No. 28,061; W. Scott Railton, Reg. No. 23,039; Gene A. Tabachnick, Reg. No. 33,801; Maria N. Rullo, Reg. No. 37,433; Barry J. Coyne, Reg. No. 43,566; Kirsten R. Rydstrom, Reg. No. 38,603; Paul D. Bangor, Jr., Reg. No. 34,768; Charles H. Dougherty, Jr., Reg. No. 42,494; Cheryl L. Gastineau, Reg. No. 39,469; Ian K. Samways, Reg. No. 36,664; Marc J. Farrell, Reg. No. 37,826; Stanley P. Fisher, Reg. No. 24,344; Robert D. Kucler, Reg. No. 45,908; Juan Carlos A. Marquez, Reg. No. 22,077; Gerald Kiel, Reg. No. 25,116; Eugene LeDonne, Reg. No. 35,930; Jules Goldberg, Reg. No. 24,408; Lloyd McAulay, Reg. No. 20,423; Harold Nissen, Reg. No. 17,283; Arthur Dresner, Reg. No. 24,403; Stephen Chin, Reg. No. 39,938; Mark Montague, Reg. No. 36,612; Samir Patel, Reg. No. 44,998 and Mary E. Buckles, Reg. No. 31,907.

Address all telephone calls to Cheryl L. Gastineau at telephone number (412) 288-4152.

Address all correspondence to: Cheryl L. Gastineau  
REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor's Signature	_____	Date: _____
Full name of sole or first inventor	IYER, Vijay K.	
Residence	Kennesaw, Georgia	
Citizenship	India	
Post Office Address	175 Chastain Meadow Court Kennesaw, GA 30144	

Inventor's Signature	_____	Date: _____
Full name of second inventor	JOHNSON, Robert M.	
Residence	Atlanta, Georgia	
Citizenship	United States of America	
Post Office Address	2 Southerland Rd. Savannah, GA 31411-2536	

Inventor's Signature	_____	Date: _____
Full name of third inventor	BUSCHMANN, Johannes	
Residence	Munich, Federal Republic of Germany	
Citizenship	Federal Republic of Germany	
Post Office Address	Birkenleiten 9 D-81453 Munich, Federal Republic of Germany	

Inventor's Signature	_____	Date: _____
	REED SMITH LLP	
	P.O. Box 488	
	Pittsburgh, PA 15230	
	(412) 288-3131	

Full name of fourth inventor  
Residence  
Citizenship  
Post Office Address

MLKOWSKI, Reinhold  
Munich, Germany  
Federal Republic of Germany  
Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany

Inventor's Signature  
Full name of fifth inventor  
Residence  
Citizenship  
Post Office Address

CUTLER, Christopher A.  
Centerville, Utah  
United States of America  
220 West 2150 North  
Centerville, UT 84014

Date: \_\_\_\_\_

Inventor's Signature  
Full name of sixth inventor  
Residence  
Citizenship  
Post Office Address

WALLACE, William D.  
Salt Lake City, Utah  
United States of America  
5038 Memory Lane  
Salt Lake City, UT 84117

Date: \_\_\_\_\_

Inventor's Signature  
Full name of seventh inventor  
Residence  
Citizenship  
Post Office Address

SMITH, Steven R.  
Draper, Utah  
United States of America  
1116 East 13200 Street  
Draper, UT 84020

Date: \_\_\_\_\_

Inventor's Signature  
Full name of eighth inventor  
Residence  
Citizenship  
Post Office Address

McGRAW, Daniel J.  
Herriman, Utah  
United States of America  
15140 South Shaggy Mountain Road  
Herriman, UT 84065

Date: \_\_\_\_\_

Inventor's Signature  
Full name of ninth inventor  
Residence  
Citizenship  
Post Office Address

TU, Nick  
West Palm Beach, Florida  
United States of America  
6333 Lauderdale St.  
West Palm Beach, FL 33410

Date: \_\_\_\_\_

Inventor's Signature  
Full name of tenth inventor  
Residence  
Citizenship  
Post Office Address

MONTAGNOLI, Clifford G.  
Murray, Utah  
United States of America  
5758 South Butler Circle  
Murray, UT 84107

Date: \_\_\_\_\_

REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
(412) 288-3131



Inventor's Signature  
Full name of eleventh inventor  
Residence  
Citizenship  
Post Office Address

BANKS, Trent W.  
Salt Lake City, Utah  
United States of America  
1129 East 5690 South  
Salt Lake City, UT 84121

Date: \_\_\_\_\_

REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
(412) 288-3131

# **EXHIBIT H**

March 29, 2001

VIA DHL

Mr. Johannes Buschmann  
Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany

Re: Patent Application of IYER, et al.  
U.S. Serial No. 09/581,122 and Brazilian Serial No. PI981043.9  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Refs.: 98-503-US and 98-503-BR

Dear Mr. Buschmann:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Falkowski, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli, and Trent. Certain documents require your signature for the Brazilian and U.S. application.

For the U.S., please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. For Brazil, please sign only (do not date) the enclosed Assignment of Priority Rights where indicated by the red marker.

Kindly return the signed documents to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed documents in the DHL envelope and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

REED SMITH LLP

By *Cheryl L. Gastineau*

Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Assignment

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063  
Delaware  
New Jersey  
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Pennsylvania  
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Virginia  
Washington, DC

Formed in the Commonwealth of Pennsylvania

"Reed Smith" refers to Reed Smith LLP and related entities.

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PGHUB-0754946.09-CLGASTIN  
March 29, 2001 11:20 AM

# **EXHIBIT I**

May 31, 2001

VIA FACSIMILE NO. 011-49-89-680-6650  
CONFIRMATION VIA DHL

Mr. Johannes Buschmann  
Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany

Re: Patent Application of IYER, et al.  
U.S. Serial No. 09/581,122 and Brazilian Serial No. PI981043.9  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Refs.: 98-503-US and 98-503-BR

Dear Mr. Buschmann:

Please note this is a second request. Our first letter sent to you was dated March 29, 2001. Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Falkowski, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli, and Trent. Certain documents require your signature for the Brazilian and U.S. application.

For the U.S., please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. For Brazil, please sign only (do not date) the enclosed Assignment of Priority Rights where indicated by the red marker.

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Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

REED SMITH LLP

By

  
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Assignment

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/o encs.)

Frederick H. Colen, Esq. (w/o encs.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063  
Delaware  
New Jersey  
New York  
Pennsylvania  
United Kingdom  
Virginia  
Washington, DC

# **EXHIBIT J**

September 24, 2001

VIA DHL

Mr. Johannes Buschmann  
Birkenleiten 9  
D-81453 Munich  
Federal Republic of Germany

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Buschmann:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Falkowski, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli and Trent.

Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed document to me as soon as possible. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed document in the DHL envelope, and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

U.S. Serial No. 09/581,122

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063  
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Pennsylvania  
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Washington, DC

Formed in the Commonwealth of Pennsylvania

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# **EXHIBIT K**



March 29, 2001

VIA DHL

Mr. Reinhold Falkowski  
Birkenleiten 9  
D-81453 Munich, Federal Republic of Germany

Re: Patent Application of IYER, et al.  
U.S. Serial No. 09/581,122 and Brazilian Serial No. PI981043.9  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Refs.: 98-503-US and 98-503-BR

Dear Mr. Falkowski:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli, and Trent. Certain documents require your signature for the Brazilian and U.S. application.

For the U.S., please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. For Brazil, please sign only (do not date) the enclosed Assignment of Priority Rights where indicated by the red marker.

Kindly return the signed documents to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed documents in the DHL envelope and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

REED SMITH LLP

By *Cheryl L. Gastineau* *dl*

Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Assignment

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

Delaware  
New Jersey  
New York  
Pennsylvania  
United Kingdom  
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Washington, DC

# **EXHIBIT L**

# ReedSmith

**TO** Mr. Reinhold Falkowski

Company

Fax 011-49-89-680-6650

Phone

**FROM** Cheryl L. Gastineau

Phone 412-288-4152

Fax 412-288-3063

Date June 1, 2001

**Total Number of Pages Including Cover Page** 7

**Original will follow via:** ☐ Regular Mail ☒ DHL ☐ Messenger ☐ None

**COPIES TO:**

Name	Company	Fax	Time Sent
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**NOTES:**

**If you do not receive all of the pages, please call Debbie at 412-288-3153.**

**Please Transmit Before:** ☐ 9 ☐ 10 ☐ 11 a.m. ☐ 12 ☐ 1 ☐ 2 ☐ 3 ☐ 4 ☐ 5 ☐ 6 ☐ 7 ☐ 8 p.m.

**Client Number:** 157848

**Matter Number:** 20177

**Attorney Number:** 1460

**Transmission Time:** Jul a.m./p.m.

**Finish Time:** 2:10 a.m./p.m.

**Operator:**

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Fax 412.288.3063

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New York  
Pennsylvania  
United Kingdom  
Virginia  
Washington, DC

May 31, 2001

VIA FACSIMILE NO. 011-49-89-680-6650  
CONFIRMATION VIA DHL

Mr. Reinhold Falkowski  
 Birkenleiten 9  
 D-81453 Munich, Federal Republic of Germany

Re: Patent Application of IYER, et al.  
 U.S. Serial No. 09/581,122 and Brazilian Serial No. PI981043.9  
 For "FETAL OXIMETRY SYSTEM AND SENSOR"  
 Respiration Ref. No. 97-30  
Our Refs.: 98-503-US and 98-503-BR

Dear Mr. Falkowski:

Please note this is a second request. Our first letter sent to you was dated March 29, 2001. Michael Haas of Respiration, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli, and Trent. Certain documents require your signature for the Brazilian and U.S. application.


For the U.S., please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. For Brazil, please sign only (do not date) the enclosed Assignment of Priority Rights where indicated by the red marker.

Kindly return the signed documents to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed documents in the DHL envelope and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respiration.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

REED SMITH LLP

By   
 Cheryl L. Gastineau

CLG:dl

Encs.: Declaration  
 Assignment  
 DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/o encs.)  
 Frederick H. Colen, Esq. (w/o encs.)

435 Sixth Avenue  
 Pittsburgh, PA 15219-1886  
 412.288.3131  
 Fax 412.288.3063  
 Delaware  
 New Jersey  
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 Pennsylvania  
 United Kingdom  
 Virginia  
 Washington, DC

# **EXHIBIT M**

FILE

ReedSmith

Cheryl L. Gastineau • 412.288.4152 • cgastineau@reedsmith.com

September 24, 2001

VIA DHL

Mr. Reinhold Falkowski  
Birkenleiten 9  
D-81453 Munich  
Federal Republic of Germany

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Falkowski:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli and Trent.

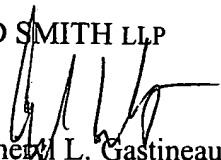
Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed document to me as soon as possible. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed document in the DHL envelope, and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By   
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

U.S. Serial No. 09/581,122

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

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Pittsburgh, PA 15219-1886  
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Fax 412.288.3063  
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September 24, 2001 12:15 PM

# **EXHIBIT N**

January 18, 2001

VIA U.S. FIRST CLASS MAIL

Mr. Nick Tu  
444 South Ivy Drive  
Midvale, UT 84047

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Johnson, Buschmann, Falkowski, Cutler, Wallace, Smith and McGraw. Although we understand that you have refused in the past to sign documents regarding the related International application, we have been required by the Patent and Trademark Office to try to obtain your signature on the papers related to the filing of the U.S. application.

Please sign and date the Declaration where indicated by the red markers. Also enclosed is an Assignment on which we also require your signature. Please sign and date it where indicated by the red markers. A copy of the above-referenced U.S. patent application is also enclosed for your reference.

Kindly return both the signed Declaration and Assignment to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed documents in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

I will be calling you within the next several days after I believe you have received this letter in the event you have any questions concerning the signing of the enclosed documents. In the meantime, should you

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Pittsburgh, PA 15219	New Jersey
412.288.3131	New York
Fax 412.288.3063	Pennsylvania
	Virginia
	Washington, DC

reedsmith.com




Mr. Nick Tu  
January 18, 2001  
Page 2

ReedSmith LLP

have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

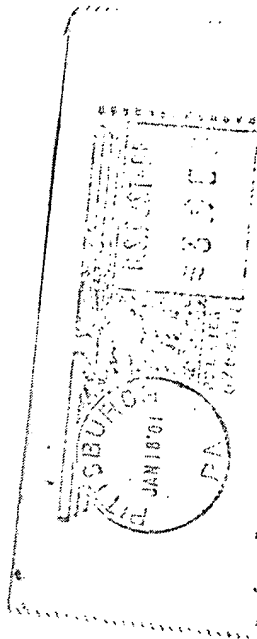
REED SMITH LLP

By   
Cheryl L. Gastineau

Encs.: Declaration  
Assignment  
Application  
Express Mail Label and Envelope

cc: Michael W. Haas, Esq. (w/o encls.)  
Frederick H. Colen, Esq. (w/o encls.)

# **EXHIBIT O**

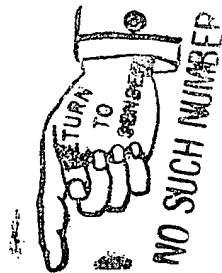


## First Class Mail

Cheryl L. Gastineau  
157848/20177/1460

ReedSmith<sup>LLP</sup>

435 Sixth Avenue  
Pittsburgh, PA 15219



Mr. Nick Tu  
444 South Ivy Drive  
Midvale, UT 84047

# **EXHIBIT P**

January 30, 2001

VIA U.S. FIRST CLASS MAIL

Mr. Nick Tu  
8188 Ivy Drive  
Midvale, UT 84047

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Johnson, Buschmann, Falkowski, Cutler, Wallace, Smith and McGraw. Although we understand that you have refused in the past to sign documents regarding the related International application, we have been required by the Patent and Trademark Office to try to obtain your signature on the papers related to the filing of the U.S. application.

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I will be calling you within the next several days after I believe you have received this letter in the event you have any questions concerning the signing of the enclosed documents. In the meantime, should you

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Pittsburgh, PA 15219  
412.288.3131  
Fax 412.288.3063  
Delaware  
New Jersey  
New York  
Pennsylvania  
Virginia  
Washington, DC

reedsmith.com

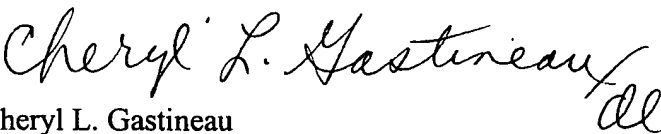
Mr. Nick Tu  
January 30, 2001  
Page 2

Reed Smith LLP

have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed documents within the next several days.

Very truly yours,

REED SMITH LLP

By   
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Assignment

Application

Express Mail Label and Envelope

cc: Michael W. Haas, Esq. (w/encs.)  
Frederick H. Colen, Esq. (w/o encs.)

# **EXHIBIT Q**

May 31, 2001

VIA U.S. FIRST CLASS MAIL

Mr. Nick Tu  
8188 Ivy Drive  
Midvale, UT 84047

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Johnson, Cutler, Wallace, Smith, McGraw, Montagnoli and Banks. Although we understand that you have refused in the past to sign documents regarding the related International application, we have been required by the Patent and Trademark Office to try to obtain your signature on the papers related to the filing of the U.S. application.

Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers.

Kindly return the signed Declaration to me immediately and no later than one week after receipt of this letter. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed documents in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

Express Mail Label and Envelope

cc: Michael W. Haas, Esq. (w/o enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

Delaware  
New Jersey  
New York  
Pennsylvania  
United Kingdom  
Virginia  
Washington, DC



# **EXHIBIT R**

September 24, 2001

VIA EXPRESS MAIL

Mr. Nick Tu  
8188 Ivy Drive  
Midvale, UT 84047

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Johnson, Cutler, Wallace, McGraw, Smith, Montagnoli and Banks. Although we understand that you have refused in the past to sign documents regarding the related International application, we have been required by the Patent and Trademark Office to try to obtain your signature on the papers related to the filing of the U.S. application.

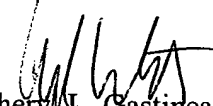
Please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By   
Cheryl L. Gastineau  
CLG:dl

Encs.: Declaration  
U.S. Serial No. 09/581,122  
Express Mail Label and Envelope

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Pittsburgh, PA 15219-1886  
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Fax 412.288.3063  
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New Jersey  
New York  
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### Tu, Nick

44 Melanie Rose Lane SW  
Lawrenceville, GA 30044  
678-376-1998

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### Tu, Nick N

6333 Lauderdale St  
West Palm Beach, FL 33410  
561-799-2014

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### Tu, Nick N

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Glendale, CA 91214  
818-249-5790

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# **EXHIBIT U**

June 3, 2002

VIA EXPRESS MAIL

Mr. Robert M. Johnson  
2 Southerland Rd.  
Savannah, GA 31411-2536

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Johnson:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Cutler, Wallace, McGraw, Smith, Tu, Montagnoli and Banks.

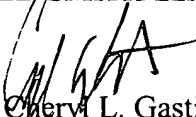
Please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days. If you believe you have received this letter in error, please notify me immediately, and return all documents in the enclosed envelope. Do not make copies, or disclose its contents to any other person.

Very truly yours,

REEDSMITH LLP

By   
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration  
U.S. Serial No. 09/581,122  
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Pittsburgh, PA 15219-1886  
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# **EXHIBIT V**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
IN THE UNITED STATES DESIGNATED OFFICE

In re PCT Patent Application of:

**Respironics, Inc. et al.**

Serial No.: PCT/US98/12394

Filed: June 15, 1998

Priority Date: June 17, 1997

Atty. Docket No.: 98-503-PCT

**FETAL OXIMETRY SYSTEM  
AND SENSOR**

Assistant Commissioner for Patents  
**BOX PCT**  
Washington, D.C. 20231

**RENEWED PETITION UNDER 37 C.F.R. § 1.425**

Sir:

In response to the Decision on Petition Under 37 C.F.R. § 1.425 dated February 3, 1999, submitted herewith is a Second Request for Filing by Other Than Inventor Under PCT Rule 4.15(b) and 37 C.F.R. § 1.425(b) with enclosures listed below:

1. Employee Agreement of Nick Tu;
2. Assignment of Intellectual Property;
3. Declaration of Michael W. Haas; and
4. Declaration of Cheryl L. Gastineau.

---

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Mailing Label No. EM385462738US. Date of Deposit: March 1, 1999. I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service on the date indicated above and is addressed to: BOX PCT, Assistant Commissioner for Patents, Washington, D.C. 20231.

Debbie LeDonne

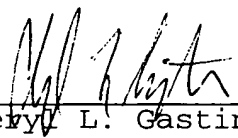


(Signature of person mailing paper or fee)

Entry of these documents and reversal of the Decision  
on Petition is respectfully requested.

Respectfully submitted,

Dated: March 1, 1999

  
\_\_\_\_\_  
Cheryl L. Gastineau  
Reg. No. 39,469  
Reed Smith Shaw & McClay LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
Phone: 412-288-4152

# **EXHIBIT W**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
IN THE UNITED STATES DESIGNATED OFFICE

In re Application of:

**Respironics, Inc. et al.**

Serial No.: PCT/US98/12394

Filed: June 15, 1998

Priority Date: June 17, 1997

Atty. Docket No.: 98-503-PCT

**FETAL OXIMETRY SYSTEM AND  
SENSOR**

Assistant Commissioner for Patents  
**BOX PCT**  
Washington, D.C. 20231

**SECOND REQUEST FOR FILING BY OTHER THAN INVENTOR**  
**UNDER PCT RULE 4.15(b) AND 37 C.F.R. § 1.425(b)**

Sir:

Applicant, Respironics, Inc. respectfully requests authorization under PCT Rule 4.15(b) and 37 C.F.R. § 1.425(b) to file the above-identified International application, which was initially filed on June 15, 1998, and which designates the United States of America, on behalf of the joint inventor, Mr. Nick Tu, who refuses to join in this International application.

---

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Mailing Label No. EM385462738US. Date of Deposit: March 1, 1999. I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service on the date indicated above and is addressed to: BOX PCT, Assistant Commissioner for Patents, Washington, D.C. 20231.

Debbie LeDonne



(Signature of person mailing paper or fee)

---

**I. Interest of the Applicant, Respironics, Inc.**

The Applicant, Respironics, Inc., is an entity to whom the inventor has agreed in writing to assign the invention under 37 C.F.R. § 1.425(b) as evidenced by the following:

1) an Employee Agreement executed by Mr. Nick Tu on July 9, 1996, a copy of which is attached hereto as Attachment 1, in which Mr. Tu agrees that all inventions invented by Mr. Tu during his employment with CLINICAL INNOVATIONS are the property of CLINICAL INNOVATIONS. See page 1, paragraph numbered 3 in the Employee Agreement in Attachment 1; and

2) an Assignment of Intellectual Property effective August 21, 1998 executed by a representative of CLINICAL INNOVATIONS, Mr. Christopher A. Cutler, on August 25, 1998, a copy of which is attached hereto as Attachment 2, in which CLINICAL INNOVATIONS agrees to assign all rights to the technology relating to fetal pulse oximetry accrued through its Employee Agreements, including the subject matter of provisional U.S. Patent Application No. 60/050,958, from which the present International application claims priority, and the present International Patent Application No. PCT/US98/12394.

**II. Proof of the Pertinent Facts**

As evidenced by the Declaration of Michael W. Haas, Esq. attorney for the Applicant, Respironics, Inc., a copy of which is attached hereto as Attachment 3, Mr. Tu has refused

to execute the International application after reasonable and diligent efforts were taken to cause the non-signing inventor to join in the International application. For example, as set forth in Mr. Haas' Declaration, Mr. Tu was made aware of the filing of the International application through Mr. Haas' letters of June 22, 1998 and July 7, 1998 and telephone conversations of July 6, 1998 and July 13, 1998. In these letters and telephone conversations Mr. Haas requested that Mr. Tu join in the present application by granting power of attorney to Mr. Haas and the undersigned so that either Mr. Haas or the undersigned may execute the Request on behalf of Mr. Tu. See page 2 of Mr. Haas' Declaration in Attachment 3.

Mr. Tu evidenced his intent to refuse to execute the International application by failing to return the Power of Attorney form included with the June 22, 1998 and July 7, 1998 letters, which he acknowledged receiving, and by his explicit request during the telephone conversation of July 13, 1998 that Mr. Haas not call him again. See page 2 of Mr. Haas' Declaration in Attachment 3. Mr. Tu's intent to refuse to join in the above-identified International application is further evidenced and buttressed by Mr. Tu's second refusal to discuss the application and second explicit request the Mr. Haas not call him again, which occurred during the telephone conversation that took place on or about July 27, 1998. See pages 2-3 of Mr. Haas' Declaration in Attachment 3.

Mr. Tu further evidenced his intent to refuse to execute the International application by failing to sign and return the Request for filing the International application ("the Request") which he acknowledged receiving in a telephone conversation with the undersigned on February 22, 1999. During this telephone conversation, Mr. Tu further indicated that he refused to sign the Request. See Ms. Gastineau's Declaration in Attachment 4.

**III. The Action is Necessary to Preserve the Rights of the Parties or Prevent Irreparable Damage**

An Invitation to Correct Defects in the International Application was mailed on July 10, 1998. Item 1(a) on page 2 of the Invitation to Correct Defect indicates that the Request was not signed by all of the applicants and item 1(d) indicates that the Request was signed by the Agent but that no power of attorneys were provided appointing her the agent of the applicants.

A first Request for Filing Other Than Inventor was filed on September 1, 1998. A Decision on Petition under 37 C.F.R. § 1.425 dated February 3, 1999, dismissed the Request for Filing Other Than Inventor as not demonstrating that Mr. Tu was given the Request (PCT/RO/101) to sign. Accordingly, the undersigned provided Mr. Tu with a copy of the Request which he refused to sign (See Ms. Gastineau's Declaration).



Thus, the Applicant Respironics, Inc. must execute the above-identified International Application on behalf of Mr. Tu, given his express refusal to join or cooperate with the prosecution of this application, in order to comply with the July 10, 1998 Invitation to Correct Defects in the International Application and, thus, preserve the rights of Applicants.

**IV. Last Known Address of the Non-Signing Inventor**

The last known address of Mr. Nick Tu is as follows:

444 South Ivy Drive,  
Midvale, Utah, 84047

The last known phone numbers for Mr. Tu are: (801) 566-9209 (home) and (801) 566-1449 (mobile phone).

**V. Conclusion**

For the reasons presented above Applicants respectfully submit that Mr. Tu, who is believed to be an inventor in the above-identified International patent application, has demonstrated a refusal to join in the application by his failure to sign and return the papers necessary to execute the application, as set forth in the Declaration of Mr. Haas at Attachment 3 and in the Declaration of Ms. Gastineau at Attachment 4.

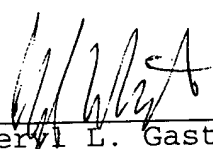
Accordingly, Applicant, Respironics, Inc. respectfully requests that authorization under PCT Rule 4.15(b) and 37 C.F.R. § 1.425(b) to file the above-identified International application

on behalf of the non-signing joint inventor, Mr. Nick Tu, be  
granted and that a Notice to that effect be provided.

Entry of these documents is respectfully requested.

Respectfully submitted,

Dated: March 1, 1999



---

Cheryl L. Gastineau  
Reg. No. 39,469  
Reed Smith Shaw & McClay LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
Phone: 412-288-4152

# EXHIBIT X

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
IN THE UNITED STATES RECEIVING OFFICE

In re PCT PATENT APPLICATION of  
RESPIRONCS, Inc.

International Appln. No.: PCT/US98/12394

International Filing Date: June 15, 1998

Earliest Priority Date: June 17, 1997

Attorney Docket No.: 98-503-PCT

**FETAL OXIMETRY SYSTEM AND  
SENSOR**

Hon. Commissioner of Patents and Trademarks  
BOX PCT  
Washington, D.C. 20231

**DECLARATION OF MR. MICHAEL W. HAAS**

Sir:

I am the intellectual property counsel for the Applicants, RESPIRONICS, Inc.

On information and belief, Mr. Nick Tu is an inventor in the above-identified PCT patent application.

I sent Mr. Tu a letter dated June 22, 1998 indicating that the above-identified PCT patent application was filed on June 15, 1998. The June 22, 1998 letter included a Power of Attorney to give Cheryl Gastineau and myself power to represent Mr. Tu in all competent International Authorities in connection with the above-identified PCT patent application, which includes signing the Request on his behalf. This letter also included an Assignment of Mr. Tu's inventorship rights to the Applicant, RESPIRONICS, Inc. A copy of the June 22, 1998 letter and enclosures are attached hereto as Attachment A.

Having not received the executed Power of Attorney or Assignment, I contacted Mr. Tu, via telephone, on July 6, 1998 at 801-566-1449. During this telephone conversation, I notified Mr. Tu that the above-identified PCT application, in which he is named as an inventor, was filed and referred him to my June 22, 1998 letter in this regard. I also requested that he review the Power of Attorney and Assignment forms and return the executed copies in order to comply with PCT Rule 4. Mr. Tu indicated that he understood that an application was filed and noted that he was not sure what he did with the copy I provided. He also indicated that he was too busy to look for them. He did not agree to return the executed forms, did not agree to search for the copies I sent and did not agree to cooperate in executing the forms necessary to perfect the filing of the above-identified application.

The next day, July 7, 1998, I sent Mr. Tu a second copy of the PCT application, Power of Attorney, and Assignment forms via overnight courier. A copy of the July 7, 1998 letter is attached hereto as Attachment B. The July 7, 1998 letter again requested that he review and return the enclosed Power of Attorney and Assignment forms as soon as possible.

Having still not received the executed Power of Attorney or Assignment, I again contacted Mr. Nick Tu, via telephone, on July 13, 1998, again at 801-566-1449. Mr. Tu indicated that he received the letter. He did not agree to return the enclosed Power of Attorney or the Assignment form or cooperate in the filing of the PCT application. He refused to explain why he was unwilling to join in the present invention. At the conclusion of the telephone conversation, Mr. Tu requested that I not call him again.

In an attempt to ascertain, for certain, Mr. Tu's intention not to join in the present PCT application, I contacted Mr. Tu via telephone at the above telephone number on or about

PCT Appln. No.: PCT/US98/12394

27, 1998. Mr. Tu repeated his request that I not call him again and immediately terminated the telephone conversation without explaining why he remains unwilling to join in the present application.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: August 25, 1998

Name: Michael W. Haas

Title: Intellectual Property Counsel

Signature: Michael W. Haas

# **EXHIBIT Y**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
IN THE UNITED STATES DESIGNATED OFFICE

In re PCT Patent Application of:

**Respironics, Inc. et al.**

Serial No.: PCT/US98/12394

Filed: June 15, 1998

Priority Date: June 17, 1997

Atty. Docket No.: 98-503-PCT

**FETAL OXIMETRY SYSTEM  
AND SENSOR**

Assistant Commissioner for Patents  
**BOX PCT**  
Washington, D.C. 20231

**DECLARATION OF MS. CHERYL L. GASTINEAU**

Sir:

I am a patent agent with Registration No. 39,469 with  
Reed Smith Shaw & McClay LLP, P.O. Box 488, Pittsburgh,  
Pennsylvania 15230.

I sent Mr. Nick Tu a letter dated February 15, 1999.  
Enclosed with the letter was a copy of the Request for filing of  
an International application based on U.S. provisional Patent  
Application No. 60/050,958 ("the Request"). Also enclosed was an  
Assignment of Mr. Tu's inventorship rights to the invention in  
the above-referenced application to the Applicant, Respironics,  
Inc. The letter requested Mr. Tu to sign and date both the  
Request and the Assignment.



I contacted Mr. Tu via telephone on February 22, 1999, at 801-566-1449. During this telephone conversation, Mr. Tu indicated that he had received my letter with its enclosures and that he would not sign the Request as he would prefer not to get involved.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

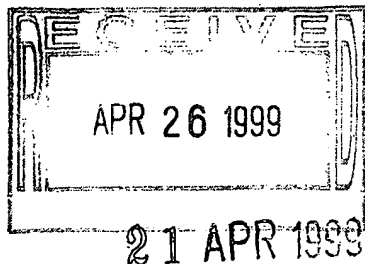
Date: March 1, 1999

Name: Cheryl L. Gastineau

Title: Patent Agent

Signature: 

# **EXHIBIT Z**



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

Cheryl L. Gastineau  
Reed, Smith, Shaw & McClay, LLP  
P.O. Box 488  
Pittsburgh, PA 15230

In re Application of  
RESPIRONICS, INC.  
PCT No.: PCT/US98/12394  
Int. Filing Date: 15 June 1998  
Priority Date: 17 June 1997  
Attorney's Docket No.: 98-503 PCT  
For: FETAL OXIMETRY SYSTEM AND SENSOR

: DECISION ON  
:  
: RENEWED PETITION  
:  
: UNDER 37 CFR 1.425  
:  
:

This decision is in response to a second Renewed Petition Under 37 CFR § 1.425 filed on 02 March 1999 in response to the decision mailed 03 February 1999, requesting that the above-captioned international application be accepted without the signature of applicant/co-inventor Nick Tu.

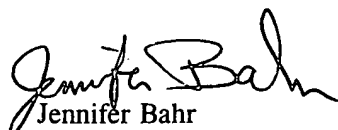
The statement of Cheryl L. Gastineau accompanying the renewed petition together with the previously filed statements are sufficient to reasonably establish that co-inventor Nick Tu has refused to sign either the Request or a power of attorney for this application.

Accordingly, acceptance of the international application under 37 CFR 1.425 and PCT Rule 4.15(b) without the signature of Nick Tu is appropriate.

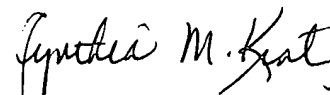
CONCLUSION

For the reasons given above, applicants' petition that the international application be accepted under 37 CFR 1.425 without the signature of applicant/inventor Nick Tu is GRANTED.

The international application is being returned to the United States Receiving Office for continued processing.

  
Jennifer Bahr  
Legal Examiner  
PCT Legal Office

CMK:JB/cmk

  
Cynthia M. Kratz  
Petitions Attorney  
PCT Legal Office

Telephone: 703-306-5467  
Facsimile: 703-308-6459

4-26-99